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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HAQ, SHAFIQUL

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1641

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,563	Applicant(s) SCHAFFER ET AL.	
	Examiner SHAFIQU HAQ	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1953.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121 and 372:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. The various invention groups are as follows:

- I. Claims 1-29, directed to a method for characterizing an analyte by MALDI mass spectrometry wherein the method requires light absorbing label comprises a fluorophore moiety.
 - II. Claims 30-31, directed to method for characterizing an analyte MALDI mass spectrometry wherein a step is required to quantify the analyte before detecting the desorbed analyte.
 - III. Claims 32-49, directed to a labeled analyte compound of generic structure F-D-L-A or D-F-L-A (claims 32) or F-D-L-R or D-F-L-R (claim 33).
 - IV. Claim 50, directed to a kit.
 - V. Claims 51-53, directed to a kit.
2. The invention groups listed in groups I-V do not relate to a single general inventive concept under PCT rule 13.1 because invention I relates to coupling of a fluorogenic detection method with MALDI mass spectrometry and invention 2 has

Art Unit: 1641

not technical link to the particular method according to invention I. The technical features of both inventions are therefore significantly different. Independent claim 32 or 33 claims a conjugate (a labeled analyte compound) and the "light absorbind labels having a reactive functionality" is not a claimed component in the base claims 32 and 33 and the "matrix forming compound" and the "ion exchange resin" of the kits are not a recited component of the base claims 32 and 33. The kit of Group III and Group IV comprises different components. All these render the concerned claims non-unitary, contrary to Rule 13.1 PCT. Further, the invention groups listed in groups I-II do not relate to a single general inventive concept under PCT rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reason: Claims 32 and 33 (Group II), at least is anticipated by linker fluorophore conjugates disclosed in prior arts US 20030077595 and WO 00/02895. Consequently, the special technical feature (i.e. labeled analyte compound) which should link claims of Groups I-V, does not provide a contribution over the prior art. As MPEP 1893.03(d) notes "The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art." In current case, Group II (Claims 32-49) is drawn to a labeled analyte compound, but the group do not make a contribution over the prior art because the invention is taught by prior arts (US 20030077595 and WO 00/02895). Therefore, inventions of group I-V are not so linked as to form a single general inventive concept and the lack of unity requirement is proper.

Art Unit: 1641

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).
4. The election of the invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Furthermore, this application contains claims that are generic to multiple patentably distinct species.

Therefore,

upon election of Group I, an election of a single species, including an exact definition of each substitution on the base molecule, wherein a single member at

Art Unit: 1641

each substituent group or moiety is selected, is further required in accordance with the practice set forth in MPEP 803.02 for the following:

1) a single species for “light absorbing label”. (e.g. if “fluorophore” is elected, election of a single species of fluorophore is further required),

2) a single species for “matrix” (including a single species of a matrix comprising compound that absorbs light),

3) a single species for “cleavage agent” (see claim23-24),

4) a single species for "lysine reactive agent" (see claims 25-26).

Upon election of Group II, an election of a single species, including an exact definition of each substitution on the base molecule, wherein a single member at each substituent group or moiety is selected, is further required in accordance with the practice set forth in MPEP 803.02 for the following:

1) a single species for “light absorbing label”. (e.g. if “fluorophore” is elected, election of a single species of fluorophore is further required),

2) a single species for “matrix” (including a single species of a matrix comprising compound that absorbs light).

Upon election of Group III, an election of a single species is required in accordance with the practice set forth in MPEP 803.02 for the following:

1) A single species of a labeled analyte by electing a single species for “F”, “D”, “L”, “A” and “R” with clearly defined linkage (a single order), including an exact definition of each substitution on the base molecule, wherein a single member at each substituent group or moiety is selected.

Upon election of Group IV, an election of a single species is required in accordance with the practice set forth in MPEP 803.02 for the following:

- 1) a single species for “light absorbend label” and
- 2) a single species for “a matrix”.

Upon election of Group V, an election of a single species is required in accordance with the practice set forth in MPEP 803.02 for the following:

- 1) a single species for “a compound” and
- 2) a single species for “an ion exchange resin”.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Chemical structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The presumption even for similar chemical structures though is not irrefutable, but may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holding of Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lulu, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for these patentability distinct species due to their mutually exclusive characteristics. The species require different field of search (e.g. searching different classes/subclasses or electronic resources, or employing different search queries); and/or the species are likely to raise different non-prior art issues under 35 U.S.C 101 and/or 35 U.S.C 112, first paragraph.

Upon the election of a single disclosed compound (e.g. Example, page number and structural depiction), the scope of the invention, inclusive of the elected compound, will be identified by the Examiner for examination along with the elected species. Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon. In the instant case, upon election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all compounds within the scope of the claim, which fall into the same class and subclass as the elected compound, but may also include additional compounds, which fall in related subclasses. Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected compound will be determined.

All compounds falling outside the class(es) and subclass(es) of the selected compound and any other subclass encompassed by the election above will be directed to nonelected subject matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. (The provisions of 35 U.S.C. 121 applies with regard to double patenting covering divisional applications.)

If desired upon election of a single compound, **applicants can review the claims and disclosure to determine the scope of the invention and can set forth a group of compounds, which are so similar within the same inventive concept and reduction to practice.** Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

6. **Applicant is advised that a reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species

Art Unit: 1641

requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. The species described above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding technical features for the following reasons: Pursuant to PCT Rule 13.2 and PCT Administrative instructions, Annex B, Part 1 (f)(I)(B)(2), the species are not art recognized equivalents.

Art Unit: 1641

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). Applicant is advised that a reply to this requirement must also include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.
9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(1)

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shafiqul Haq whose telephone number is 571-272-6103. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Shibuya can be reached on 571-272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shafiqul Haq/
Examiner, Art Unit 1641